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Supreme Court of the United States.

OCTOBER TERM, A. D. 1903.

HOWE SCALE COMPANY OF 1886 AND FAY-SHOLES COMPANY,
Petitioners.

vs.

TYCKOFF, SEAMANS & BENEDICT,
Respondent.

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PETITION FOR CERTIORARI.

AUSTEN G. FOX,
JAMES H. PEIRCE,
GEORGE P. FISHER, JR.,
WM. HENRY DENNIS,
Attorneys and of Counsel for Petitioners.

Rollins Bros., Law Printers, 358 Dearborn St., Chicago.

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IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1903.

HOWE SCALE COMPANY OF 1886 AND FAY-SHOLES COMPANY,
Petitioners,

vs.

WYCKOFF, SEAMANS & BENEDICT,
Respondent.

Petition for Writ of Certiorari requiring the United States Circuit Court of Appeals for the Second Circuit to certify to the United States Supreme Court for its review and determination the case of Wyckoff, Seamans & Benedict, Complainant-Appellee, vs. Howe Scale Company of 1886, Defendant-Appellant.

To the Supreme Court of the United States of America:

Your petitioner, Howe Scale Company of 1886, a corporation organized and doing business under and by virtue of the laws of the State of Vermont, and your petitioner, Fay-Sholes Company, a corporation organized and doing business under and by virtue of the laws of the State of Illinois, respectfully show to this court as follows, viz.:

1. That complainant, Wyckoff, Seamans & Benedict, is a corporation organized under the laws of the State of

New York with its principal place of business at Ilion in said state, and is engaged in the manufacture and sale of typewriting machines which for many years past have been generally known by the names "Remington" and "Remington Standard," and have been invariably marked conspicuously with the name "REMINGTON," with the name "REMINGTON STANDARD TYPEWRITER," with a large RED SEAL trade-mark and with the name and address "REMINGTON STANDARD TYPEWRITER, MANUFACTURED BY WYCKOFF, SEAMANS & BENEDICT, ILION, N. Y., U. S. A." That the business of the manufacture of said typewriting machines under said names "Remington" and "Remington Standard Typewriter," and designated by said Red Seal trade-mark, was begun by the corporation E. Remington & Sons, of Ilion, N. Y., which corporation long prior thereto had achieved a world-wide reputation for its firearms, sewing machines, agricultural implements and other machinery. That complainant, Wyckoff, Seamans & Benedict, acquired its title to such part only of the business of said corporation E. Remington & Sons as concerned the manufacture and sale of typewriting machines by virtue of an assignment reserving to said E. Remington & Sons the right to reengage in the manufacture and sale of typewriting machines at any time after ten years from its date, viz., March 22, 1886.

2. That your petitioner, Fay-Sholes Company, was incorporated under the laws of the State of Illinois in April, 1897, under the name Remington-Sholes Company, and at such time succeeded to the business (including good-will, trade-marks, etc.) of the Remington-Sholes Typewriter Company, a corporation organized un-

der the laws of the State of Illinois in the year 1894. At the time of the bringing of this suit, your petitioner, Howe Scale Company of 1886, was acting as the general sales agent for the United States for said corporation Remington-Sholes Company, and as such sales agent had its offices in various cities throughout the United States.

3. That the capital stock of said Remington-Sholes Typewriter Company at the time of its organization consisted of 1,500 shares of the par value of one hundred dollars each, and these shares were subscribed for as follows, viz.: Franklin Remington, 561 shares; Carver Remington, 562 shares; Zalmon G. Sholes, 374 shares; Norman Hapgood, one share; C. L. Hamill, one share, and L. Thompson one share, and upon the completion of the organization of said Remington-Sholes Typewriter Company the following officers were chosen, viz.: Charles N. Fay, president; Franklin H. Head, vice-president; Franklin Remington, general manager; Zalmon G. Sholes, superintendent, and Franklin Remington, Carver Remington, Zalmon G. Sholes and Messrs. Fay and Head, directors. That the typewriting machine, for the manufacture of which said Remington-Sholes Typewriter Company was so organized, was the invention of said Zalmon G. Sholes, and that said Franklin Remington, prior to the organization of said corporation, had devoted many months and had expended some fifteen thousand dollars in the reconstruction of said typewriting machine and in enlisting capital for its manufacture. That not only was the organization of said Remington-Sholes Typewriter Company effected by said Remingtons and said Sholes, but from the beginning of said enterprise said Franklin Remington and said Sholes devoted their entire time and energies to the management

of the business of said corporation. That the father of said Zalmon G. Sholes was recognized as a pioneer inventor of typewriting machines and the father of said Carver and Franklin Remington was at one time president of the corporation E. Remington & Sons, which corporation had acquired a world-wide reputation for its manufacture of firearms, sewing machines, etc., and which corporation in 1873 began the manufacture of typewriting machines embodying the inventions of the father of said Zalmon G. Sholes.

4. Your petitioners further show that the typewriting machines placed upon the market by said Remington-Sholes Typewriter Company were extensively advertised as and known by the name "Remington-Sholes" and were conspicuously marked with the name and address "Remington-Sholes, Chicago," but after the summer of 1887 and after the business of said Remington-Sholes Typewriter Company had been acquired by the Remington-Sholes Company, all the typewriting machines manufactured by said last-named company and sold by your petitioner, Howe Scale Company of 1886, were conspicuously marked with the registered trade-mark "Rem-Sho" and with the name and address "Remington-Sholes Company, Mfrs. Chicago", and with no other mark or words. That all advertising material (circulars, posters, business cards, etc.) issued by said Remington-Sholes Typewriter Company, by said Remington-Sholes Company and by their agents, have been invariably accompanied by the full name and address of said companies conspicuously displayed thereon. That each machine placed upon the market by said Remington-Sholes Typewriter Company from the inception of its business and by its successors up to the middle of the year 1900 (nearly two years

after the filing of the bill of complaint in this cause) had a highly ornamental bronze frame of very unique design, differing so widely in shape and coloring from the conventional black enamel frames invariably used for complainants' and other typewriting machines that the confusion of the machines of said Remington-Sholes Typewriter Company and its successors with machines of complainants' manufacture was impossible by persons familiar with the appearance of complainants' machines. That said Remington-Sholes Typewriter Company, its successors and your petitioner, Howe Scale Company of 1886, have at all times scrupulously sought to avoid any confusion as to identity of their machines with machines of complainants' manufacture and have uniformly and industriously pointed out by catalogues and other advertising matter that their machines had no connection whatever with the typewriter of complainant's manufacture. That in furtherance of said purpose, your petitioners have, from the inception of their business, distributed through their various offices, and in vast numbers, catalogues containing, *mutatis mutandis*, the following statement:

> "In Regard to Our Name. The question is often asked, 'What connection has the Remington-Sholes Company with the Remington Standard Typewriter?' We answer, none whatever. The 'Rem-Sho' Typewriter is manufactured by the Remington-Sholes Company in Chicago, Ill., U. S. A. It originated in the brain of Mr. Zalmon G. Sholes, a son of the original inventor of the Remington Standard Typewriter. In 1893 Mr. Sholes came to Mr. Remington, a son of the original manufacturer of the well-known typewriter which bears his name, and laid his plans and the results of his work before him. The two formed a partnership and began at once to develop the typewriter with which they are now identified. Later, a Company was formed of strong capitalists to manufacture the machine and

put it on the market, since when it has been tested by four years' use and the Nos. 2, 3, 4 and 5 Models brought out under the personal supervision of Mr. Fay.

"We state then, emphatically, that this Company has no connection whatever with that well known and excellent machine, the Remington Standard Typewriter, and caution all possible customers against confusing the 'Rem-Sho' with that machine or any other.

"We are sometimes asked about the right of the Messrs. Remington and Sholes to the use of their own names in connection with typewriters. In answer we would say that the law is absolutely clear that every man has the right to use or permit the use of his own name (which is his birthright) in business, provided it is so used as not to deceive. In order to prevent deception *absolutely*, we have made our machine, in finish and outward appearance, entirely unique, and in all public advertisements, signs, marks and statements, we are careful to set forth that it must not be confounded with any other. This is in accordance with law and good faith, and renders our use of these names morally and legally unassailable."

5. Your petitioner, Fay-Sholes Company, further shows that for several years prior to the bringing of this suit in September, 1898, the typewriting machine manufactured by your said petitioner's predecessor, Remington-Sholes Typewriter Company, and as well also the typewriting machines of complainants' manufacture, were being extensively sold not only in all the principal cities of this country, but also in the principal cities of most of the civilized countries throughout the world. That in the year 1896, while the machine manufactured by said Remington-Sholes Typewriter Company and marked with the words "Remington-Sholes, Chicago," were being sold in the German Empire by one Henry Newald, a suit was there brought against said Newald

by Glogowski & Co., of Berlin, Germany, who were agents for complainant, Wyckoff, Seamans & Benedict, the said Glogowski & Co. having registered the name "Remington" as a trade-mark for typewriting machines in the German Patent Office; that said suit went from the lower courts of the German Empire to the German Imperial Supreme Court and it was there held that in view of the history of the Remington-Sholes Typewriter Company as disclosed by the proofs in said cause, the name "Remington-Sholes" could be properly and lawfully used upon machines manufactured by said Remington-Sholes Typewriter Company, as will appear by a translation of the opinions of said German courts accompanying this petition and marked "Exhibit A," verified copies of such opinions and translations thereof having been served upon complainant's counsel during the taking of the testimony in this cause.

6. That in September, 1898, complainant, Wyckoff, Seamans & Benedict, filed its bill of complaint in this cause against your petitioner, Howe Scale Company of 1886, in the United States Circuit Court for the District of Vermont; that said bill of complaint alleged *inter alia* that complainant's predecessor in business had registered the words "Remington" and "Remington Standard" as trade-marks for typewriting machines in the United States Patent Office on or about October 23, 1888, and made profert of said original certificates of registration or duly authenticated copies thereof and asserted that said registered trade-marks were duly assigned and transferred to and owned by said complainant and that said trade-marks "Remington" and "Remington Standard" were of value far in excess of one hundred thousand dollars; that in said bill of complaint it was further al-

leged *inter alia* that your petitioner, Howe Scale Company of 1886, had imitated and infringed upon the trade-mark and trade-name "Remington" to which said complainant in said bill of complaint asserted an exclusive right; and in said bill of complaint it was further alleged *inter alia* that your petitioner, Howe Scale Company of 1886, had been guilty of unfair trade competition by using in connection with the sale of typewriting machines the abbreviated name "Rem-Sho" and the corporate name of said Remington-Sholes Company. That after the filing of the bill of complaint in said cause an answer thereto was duly filed on behalf of your petitioner, Howe Scale Company of 1886, and after replication filed by complainant, and after testimony to the extent of some 1,500 printed pages was taken, the cause came on for hearing on May 28th, 1901, before his Honor Hoyt H. Wheeler, United States Circuit Judge for the District of Vermont, and was argued by counsel for complainant and defendant; that after taking said cause under advisement his Honor Judge Wheeler rendered an opinion (a copy of which accompanies this petition and is marked "Exhibit B") and entered a decree (a copy whereof accompanies this petition and is marked "Exhibit C") by which it was decreed *inter alia* that your petitioner, Howe Scale Company of 1886, and all persons acting in privity with it, be enjoined from making use of the designation "Remington" or "Rem" as the name or part of the name of any typewriting machine whatsoever manufactured by said Remington-Sholes Company or by defendant or by any other person or concern, and from in any manner whatsoever making use of the word "Remington" or the abbreviation "Rem" as the whole or as a part of any name or designation whatsoever which shall be marked upon or affixed or ap-

plied by any means to typewriting machines manufactured and sold by said Remington-Sholes Company or by defendant or by any person or concern. That after the entry of said decree made by his Honor Judge Wheeler as aforesaid your petitioner, Howe Scale Company of 1886, took an appeal in due form of law to the United States Circuit Court of Appeals for the Second Judicial Circuit. That said appeal came on for hearing before their Honors Judges Wallace, Lacombe and Coxe at the city of New York on the 7th day of February, 1903, and at such time was argued by counsel for complainant and defendant; that after the argument of said appeal said cause was taken under advisement by said Court of Appeals until the 9th day of April, 1903, when opinions were rendered by the several judges of said Court of Appeals, copies of which opinions accompany this petition and are marked "Exhibit D;" that by said opinions the decree of the lower court was found to be erroneous and was reversed in so far as said lower court had enjoined your petitioner, Howe Scale Company of 1886, from the use of the trade-mark "Rem-Sho," but the opinions of Judges Lacombe and Coxe found that the decree of the lower court was correct in so far as it enjoined your petitioner, Howe Scale Company of 1886, from the use of the name "Remington" as ordered by the decree of said lower court; that the dissenting opinion of his Honor Judge Wallace found all the issues of the cause in favor of your petitioner, Howe Scale Company of 1886. That on the 22nd day of April, 1903, an order for mandate (a copy whereof accompanies this petition and is marked "Exhibit E") was entered by said Court of Appeals in conformity with

said opinions of said Judges Lacombe and Coxe, said order being as follows, viz.:

> "It is now hereby ordered, adjudged and decreed that the decree of said Circuit Court be and it hereby is reversed without costs, and cause remanded with instructions to decree in favor of complainant only as to the name 'Remington.'"

That after the entry of said order of said Court of Appeals and the issuance of the mandate thereon, his Honor Judge Wheeler on the 23rd day of June, A. D. 1903, entered a final decree in the Circuit Court of the District of Vermont in which it was decreed *inter alia* that the sale by your petitioner, Howe Scale Company of 1886, of typewriting machines manufactured by or for said Remington-Sholes Company under the name of or as "Remington-Sholes" typewriters constitutes a fraudulent infringement and invasion of the rights of the complainant and an unfair and inequitable competition which equity will restrain, and that your petitioner, Howe Scale Company of 1886, and all others acting in privity with it, should be enjoined from in any manner whatsoever making use of the word "Remington" as the whole or as a part of any name or designation whatsoever which shall be marked upon or applied to typewriting machines manufactured or sold by said Remington-Sholes Company or any other person, and that complainant, Wyckoff, Seamans & Benedict, recover the costs of suit.

And your petitioners further show that the language of the decree of said Circuit Court declaring that your petitioner, the Howe Scale Company of 1886, has been guilty of "a fraudulent infringement and invasion of the rights of complainant and an unfair and inequitable competition" has been widely published and advertised by

complainant both in this and in foreign countries to the great injury of the fair fame and business reputation of your petitioner, the Fay-Sholes Company.

7. Your petitioners further show that the defense of this cause has from its inception been conducted wholly at the expense of your petitioner, Fay-Sholes Company, and by counsel of its own selection; that after the decision of his Honor Judge Wheeler enjoining the use of the name "Remington-Sholes" and the trade-mark "Rem-Sho" as aforesaid, and because of said decision your petitioner, Fay-Sholes Company (then bearing the name Remington-Sholes Company), ceased to mark its typewriting machines with the registered trade-mark "Rem-Sho" and with the inscription "Remington-Sholes Company, Mfrs. Chicago," and caused its corporate name to be changed from Remington-Sholes Company to Fay-Sholes Company, in keeping with the laws of the State of Illinois.

8. And your petitioner, Fay-Sholes Company, further shows that in October, 1901, complainant, Wyckoff, Seamans & Benedict, filed its bill of complaint in the United States Circuit Court for the Northern District of Illinois against your petitioner, Fay-Sholes Company (at that time still bearing the name Remington-Sholes Company); that said bill of complaint is based mainly upon the alleged infringement and violation by your petitioner, Fay-Sholes Company (while trading under the name Remington-Sholes Company), of complainant's alleged trade-mark "Remington" by the use by your petitioner, Fay-Sholes Company, upon and in connection with the sale of its typewriting machines of its registered trade-mark "Rem-Sho" and the inscription "Remington-Sholes Company, Mfrs. Chicago" and for alleged unfair

trade competition arising chiefly from the use by your petitioner, Fay-Sholes Company, of its trade-mark "Rem-Sho" and of its former corporate name "Remington-Sholes Company" in connection with the sale of typewriting machines of your petitioner's manufacture. That after the answer of your petitioner, Fay-Sholes Company, was filed to said bill of complaint, an order was entered in said cause staying proceedings therein until the determination of this present cause in the United States Circuit Court of Appeals and in the United States Supreme Court. But in said order so staying said cause it was provided that if this present cause resulted in favor of complainant, Wyckoff, Seamans & Benedict, the said cause in which said order was so entered should proceed at once to an accounting; that said order so entered in said cause is still in force.

9. Your petitioner, Fay-Sholes Company, further shows that for a number of years past its typewriting machines have been extensively sold in many foreign countries and particularly in the German Empire, in France, Denmark, Norway, Russia and Austria by dealers in said several countries who purchased said typewriting machines from an independent German corporation bearing the name "Remington-Sholes Company, m. b. H." (signifying "limited"), which said German corporation in turn purchased said machines from your petitioner, Fay-Sholes Company; that said dealers in said foreign countries have been threatened with litigation by complainant, Wyckoff, Seamans & Benedict, or its foreign agents or representatives because of the use upon typewriting machines (manufactured by your petitioner, Fay-Sholes Company, while trading under the name Remington-Sholes Company) of the trade-mark "Rem-Sho" and the

inscription "Remington-Sholes Company, Mfrs. Chicago," and one suit is now pending in Holland against a dealer at Rotterdam for said alleged wrongful use of said trade-mark "Rem-Sho" and said inscription "Remington-Sholes Company, Mfrs. Chicago" upon typewriting machines manufactured by your petitioner, Fay-Sholes Company; that your petitioner, Fay-Sholes Company, fears that notwithstanding the said favorable decision of the German Imperial Supreme Court serious injury may result to dealers in Germany and other foreign countries, in machines manufactured by your petitioner, Fay-Sholes Company, and to the foreign trade of your said petitioner if the decision of said Circuit Court of Appeals for the Second Circuit in this cause is allowed to stand uncorrected.

10. Your petitioners further show that in the opinion rendered by his Honor Judge Lacombe of the United States Circuit Court of Appeals for the Second Circuit in the above-entitled cause (the conclusions of which opinion were concurred in by his Honor Judge Coxe) it is stated that "we do not find in this voluminous record sufficient evidence that defendant has itself done anything to promote confusion in the mind of the public, except to use the name 'Remington' on its machines, and in its literature." Your petitioners submit that said opinion and said decree of said Court of Appeals for the Second Circuit are predicated upon the ground that notwithstanding the fact that the individuals Messrs. Remington and Sholes had an absolute right to use their own names in business, they had no right to give said names to the corporation organized by them for the express purpose of manufacturing a machine due to their joint efforts, in which corporation they owned the greater part

of the stock, to which also they were devoting their whole time and energy and of which they were officers and directors. And your petitioners submit that such ruling by said Circuit Court of Appeals is in direct violation of the rulings of this Honorable Court, as heretofore repeatedly expressed in its decisions.

11. And your petitioner, Fay-Sholes Company, further shows, as bearing upon its right to use upon its machines the trade-mark "Rem-Sho" and the words "Remington-Sholes Company, Mfrs. Chicago," the following facts:

(1) For a number of years past corporate management has been regarded as the most effective form of business enterprise; (2) the designation of corporations by personal names is not only widespread, but is universally recognized as a legitimate use of personal names; (3) all other typewriting machines upon the market are manufactured by corporations; (4) nearly all of the many typewriting machines upon the market bear the personal names of the inventors or the manufacturers of such machines; (5) nearly all the corporations engaged in the manufacture of typewriting machines bear the same personal names as their machines; (6) the Remington-Sholes Typewriter Company was organized to manufacture a machine invented solely by Mr. Sholes and developed by the capital and personal labors of Mr. Franklin Remington; (7) that the family name of Remington has been world-famous in various lines of industry since long prior to the advent of the typewriting machine, and the father of Zalmon G. Sholes was a recognized pioneer inventor of typewriting machines. Wherefore your petitioner, Fay-Sholes Company, asserts that the adoption by it of the name Remington-Sholes Com-

pany as its corporate name was reasonable and fair and was in no manner an act of unfair or inequitable competition with complainant.

12. Your petitioners submit that if it be true that an individual has an absolute right to use his name in fair and honest manner in the conduct of his own business he has a right to bestow such name upon a corporation organized by him and to which his whole capital and industry are devoted. And your petitioners submit that inasmuch as defendant here has not (as found by said Court of Appeals for the Second Circuit) "done anything to promote confusion in the minds of the public except to use the name Remington" (and that it has invariably used said name Remington only in conjunction with the name Sholes in the hyphenated name Remington-Sholes), and inasmuch as the giving of the personal names "Remington" and "Sholes" to said Remington-Sholes Company was an ordinary use of such names sanctioned by long trade custom, it would be a manifest wrong unto your petitioner, Fay-Sholes Company, to be deprived of the right to use the corporate name Remington-Sholes Company bestowed upon it by its officers and directors, Messrs. Remington and Sholes.

13. That while your petitioners may have a right to bring this cause to this court by appeal from the decision of said Circuit Court of Appeals for the Second Circuit because of the fact that the complaint in this cause is founded in part at least upon the alleged infringement of complainant's registered trade-mark "Remington," nevertheless your petitioners fear that the remedy afforded by such appeal might not be as full and complete as may be given by this court if this present petition be granted, because it may be alleged that such appeal if taken would

raise simply the technical question of the infringement of complainant's registered trade-mark and might not raise the broader question as to whether or not your petitioners have been guilty of unfair competition in the use of the corporate name "Remington-Sholes Company;" wherefore your petitioners show that if this petition is granted a more full and adequate measure of relief may be afforded your petitioners than if this cause were brought to this court by appeal.

14 And your petitioners further aver that this court has repeatedly held and more particularly in the cases of *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S., 169; *Brown Chemical Co.* v. *Myer et al.*, 139 U. S., 540, and *Elgin National Watch Co.* v. *Illinois Watch Case Co.*, 179, U. S., 665, first, that an ordinary surname can not be appropriated as a trade-mark by any one person against others of the same name who are using it for a legitimate purpose; and second, that where an alleged trade-mark is not in itself a good trade-mark, yet has come to denote the particular manufacturer or vendor, relief against unfair competition will be restricted to requiring the use of the word by another in such manner as will prevent misapprehension on the question of origin. That in the present cause the use of the surname "Remington" in the name "Remington-Sholes Company" is manifestly a legitimate use of such surname and that the use of the inscription "Remington-Sholes Company, Mfrs. Chicago" is a use in such manner as to clearly avoid misapprehension on the question of origin. But that notwithstanding said decisions of this court clearly authorizing your petitioners to use the surname "Remington" in the manner above stated, nevertheless your petitioners will be deprived of said right if the decision rendered in this cause by the Circuit

Court of Appeals for the Second Circuit and the final decree of said Circuit Court for the District of Vermont are allowed to remain uncorrected.

15. And your petitioners further show that a large part of the evidence produced in this cause on behalf of complainant related to advertisements and acts in foreign countries by certain dealers who were in no manner whatever connected with nor under the control of your petitioners or either of them, but who had purchased outright from an independent German company typewriting machines manufactured by your petitioner, the Fay-Sholes Company (then named the Remington-Sholes Company). That your petitioner, Howe Scale Company of 1886, by its counsel, duly objected to said evidence and at the hearing of this cause before the lower court moved that said evidence be disregarded, but the lower court admitted said evidence notwithstanding such objection and motion. That your petitioner, Howe Scale Company of 1886, upon the appeal of this cause to the Circuit Court of Appeals assigned as error the admission of such evidence but said assignment of error was apparently ignored by said Court of Appeals. That your petitioners aver that under the rulings of this court it was the duty of said Circuit Court and of said Circuit Court of Appeals to have sustained the motion of your petitioner, Howe Scale Company of 1886, and to have disregarded said evidence objected to as aforesaid and to have taxed the costs of such evidence against the complainant in this cause.

16. And your petitioners aver that the present case is one in which it is proper for this court to issue a writ of *certiorari* for the following reasons, among others:

(*a*) Because machines of both complainant and your

petitioner, the Fay-Sholes Company, go into the markets of the world with their respective marks and inscriptions thereon as before described, and the conflict between the before-mentioned decisions of the German Imperial Supreme Court and of the Court of Appeals for the Second Circuit will work serious injury to the foreign trade of your petitioner, the Fay-Sholes Company.

(*b*) Because the decision by this court of the questions at issue in this cause will determine the decision of the United States Circuit Court for the Northern District of Illinois in the suit now pending therein and brought by complainant, Wyckoff, Seamans & Benedict, against the Remington-Sholes Company, and thus will avoid a multiplicity of suits.

(*c*) Because this court having heretofore repeatedly decided that no one can have the right to the exclusive use of a personal name as a trade-mark, the decision rendered in this cause by the Circuit Court of Appeals is in direct contravention of such ruling of this court; and because the final decree of the United States Circuit Court for the District of Vermont of June 23, 1903, declaring as it does that your petitioner, the Howe Scale Company of 1886, has been guilty of "a fraudulent infringement and invasion of the rights of complainant and an unfair and inequitable competition," is not only in contravention of the rulings of this court, but has placed a stigma upon the fair fame and reputation of your petitioners, from which your petitioners are entitled to be relieved.

(*d*) Because this court having decided that where an alleged trade-mark is not in itself a good trade-mark yet the use of the mark has come to denote the particular vendor, relief against unfair competition will only be awarded by requiring the use of such mark by another

to be in such manner as will prevent misapprehension on the question of origin; whereas the decision rendered in this cause by the Court of Appeals for the Second Circuit, denying as it does your petitioner's right to place the inscription "Remington-Sholes Company, Mfrs. Chicago" upon its machines, is in direct contravention of the rulings of this court; and because, even if complainant were alone entitled to use the name "Remington" as a trade-mark for typewriting machines, nevertheless your petitioners have not trespassed upon such right since they have used only the names "Remington-Sholes" and "Remington-Sholes Compaany" (never the name "Remington" alone), both of which names differ so widely in appearance and sound from the name "Remington" alone that no purchaser, using the ordinary intelligence and discrimination which under the decisions of this court he is required to use, could mistake your petitioner's machine for complainant's. (*Coats* v. *Merrick Thread Co.*, 149 U. S., 562; *Corbin* v. *Gould*, 133 U. S., 308.)

(*e*) Because inasmuch as the use by Messrs. Remington and Sholes of their surnames in the corporation in which they were officers and stockholders was an ordinary, fair and reasonable use and one sanctioned by long-established custom, the decision rendered in this cause by the Circuit Court of Appeals for the Second Circuit enjoining such use is in manifest violation of your petitioners' rights and in contravention of the rulings of this court.

(*f*) Because there exists a conflict and lack of uniformity in the decisions of the various United States Circuit and state courts as to the right of an individual to bestow his name upon a corporation organized and managed by him, and the question as to the right of an individual to bestow his name upon such a corporation

when the name so bestowed resembles that of another engaged in the same business (which right is plainly denied by the decision rendered in this cause by a majority of the judges of the Circuit Court of Appeals for the Second Circuit) is a question that has not been passed upon by this court and is one in which the public is largely interested in view of the common practice existing at the present day of bestowing personal names upon corporations.

Wherefore your petitioners respectfully pray that a writ of *certiorari* may be issued out of and under the seal of this court directed to the United States Circuit Court of Appeals for the Second Circuit commanding the said court to certify and send to this court on a day certain to be therein designated a full and complete transcript of the record of all proceedings of the said Circuit Court of Appeals in this cause that such proceedings therein may be had as to this Honorable Court may seem just and that the said decree of said Circuit Court of Appeals in this cause rendered may be reversed by this Honorable Court.

And your petitioners will ever pray, etc.

HOWE SCALE COMPANY OF 1886,
By GEO. P. FISHER, JR.,
Its Attorney and Counsel.

FAY-SHOLES COMPANY,
By CHARLES N. FAY, President.

We certify that, in our opinion, the foregoing petition is well grounded in matter of law and proper to be heard.

AUSTEN G. FOX,
JAMES H. PEIRCE,
GEORGE P. FISHER, JR.,
WM. HENRY DENNIS,
Of Counsel for Petitioners.

State of Illinois, County of Cook, ss.

Charles Norman Fay, being duly sworn, says that he is the president of the Fay-Sholes Company, the petitioner of that name mentioned above; that he has read the foregoing petition and knows the contents thereof, and that the facts therein stated are true to the best of his information and belief.

CHARLES N. FAY.

Sworn to and subscribed before me this .... day of October, 1903.

ALBERTA ADAMICK,
[SEAL.] *Notary Public, Cook County, Illinois.*

EXHIBIT A.

(Decisions of German Courts.)

UNITED STATES CIRCUIT COURT,

DISTRICT OF VERMONT.

WYCKOFF, SEAMANS & BENEDICT
vs.
THE HOWE SCALE COMPANY OF 1886.
} In Equity.

TRANSLATION OF OPINIONS OF THE GERMAN COURTS IN LITIGATION REGARDING THE NAME REMINGTON-SHOLES.

OPINION OF THE GERMAN KOENIGLICHES KAMMERGERICHT.

Rendered:
July 3, 1897.
(signed) KRUG,
Court Clerk.

IN THE NAME OF THE KING.

The case of Henry Newald of Berlin, defendant, cross-complainant and appellant, represented by attorney Fuchs I of Berlin,

against

The firm, Glogowski and Co., plaintiff, cross-defendant, and appellee, represented by attorney Dr. E. Fuchs at Berlin.

In regard to the infringement of the trade mark right, the "10 Civilsenat des Konigliches Kammergericht" (Su-

preme Court of the Kingdom), have, with the concurrence of the Supreme Justice Busch chairman, Supreme Justice Rabe and Nehse, District Judges Delbruch and Kubler, decided that:—

The judgment rendered March 19, 1897 by the "vierten Kammer fur Handelssachen des Koniglichen Landgerichts *I*" at Berlin, be altered, as follows:—

1. The petition of the plaintiff is denied.

2. As to the cross-complaint, it is decreed that the plaintiffs acknowledge that they are not entitled to enjoin the defendant from selling the typewriters of the Remington Sholes Typewriter Co., or the casing or enclosures therefor, upon which this firm name is marked, nor from using this firm name in connection with advertisements and the like in the course of business.

The further prayer of the cross-complaint of the defendant and appellant is denied.

3. The costs of court are divided between the parties, the other costs of the parties are set-off against one another.

4. As security for the performance of judgement (2), the plaintiff shall furnish a bond of 10,000 M. payable in gold or in notes of the German Empire or the Prussian States, such bond to be conditioned upon the execution of the judgement.

Statement of Facts.

The plaintiffs are engaged in this city in the business of dealing in American typewriters, which they obtain from Wyckoff, Seamans & Benedict at New York. They allege that they sell in their own name and on their own account, whereas the defendant claims that they sell said machines simply as agents of the above mentioned American concern.

On Feby. 8th, 1896 the word "Remington" was entered as a Trade-Mark in the Register of the Imperial Patent Office at Berlin for and on behalf of the predecessors of plaintiffs Glogowski & Son; said trademark is in-

tended for typewriters and their parts, as well as incidentals; the line of business in which said trademark is to be used, is said to be "The sale of the aforementioned articles." This trademark has become the property of the plaintiffs. The certificate of registry introduced by the plaintiffs (Record P. 233) is considered.

The plaintiffs allege that with the consent and at the instance of Wyckoff, Seamans & Benedict they have caused this trademark to be registered; in support thereof they have introduced a copy of a document dated Oct. 3, 1894 marked "Power of Attorney", to which reference is made (Record P. 40.)

The defendant carries on in this city the sales of American typewriters made by the Remington-Sholes Typewriter Co. at Chicago. He himself states that he carries on such sales as the employe of said concern and on its account. The typewriters of said American concern introduced into commerce by the defendant, are marked with the full name of said house; such name appears likewise on the advertisements and price lists issued by the defendant; a specimen of such an advertisement is introduced for inspection (Record p. 19) and is considered.

The plaintiffs believe that the defendant, in carrying on such business, violates their trademark rights and moves for a decree as follows:

a) That the defendant, on pain of fine to be imposed in each case of violation, refrain from placing the word "Remington" either singly or in connection with other words, upon any typewriters or casings or coverings thereof, and from circulating in commerce any typewriters so marked, and from using such marks in connection with any advertisement, price-lists, letters, recommendations, bills, etc.

b) That the defendant remove the mark "Remington" from all the typewriters, price-lists, letters of recommendation and other printing matter in its possession, or in case such removal cannot be effected in any other way, then de-

stroy all typewriters and utensils bearing the aforesaid marks. To award immediate execution of the judgment on giving security.

The defendant makes a point as to his competency to be sued, because he does not sell in his own name, but as an employe of the Remington-Sholes Typewriter Co.

The defendant further insists that he has a right to use, in connection with typewriters consigned by said concern, the business name containing the word "Remington"; that said word is a proper name; that two men Franklin Remington and Carver Remington are interested in said business; that they are descendants of the first manufacturer of typewriters, Samuel R. and that years ago they associated themselves with Zalmon Sholes in a concern for the manufacture of typewriters under a business name containing the words Remington and Sholes; that said concern has produced a typewriter totally different in construction from all others; that for many years they have been selling these machines all over the world under such business name, and that its right to place such business name upon its machines has never yet been contested; that the competing house of Wyckoff, Seamans & Benedict in the United States has never sought to prevent it from placing its business name upon its articles; that only when said Wyckoff, Seamans & Benedict were about to establish a branch at Berlin, they procured the plaintiffs to have said trade-mark registered; that according to S. 13 of the trademark act the trademark rights thereby acquired would not, however prevail as against the Remington-Sholes Typewriter Co. In support of the allegation that Franklin Remington and Carver Remington are interested in said concern, the defendant has produced the affidavits of Franklin Remington and Zalmon G. Sholes, dated Sept. 3, 1896, which are referred to (see translation pp. 198-201 of record).

The defendant further insists that the plaintiffs are not legally entitled to the trade-mark Remington and under S.

9 of the trademark act he files his cross complaint asking that said trademark be stricken from the register on the ground that its contents are repugnant to actual facts and give rise to a deception. For he says that Remington is a proper name; that such was the name of the first manufacturer of typewriters at N. Y. the plaintiffs Glogowski & Co. or the partners of said firm do not bear that name and are not entitled to its use; nor has the house of Wyckoff, Seamans & Benedict in whose products the plaintiffs are dealing here, any right to use the word Remington as a trademark, as no member of the Remington family has ever permitted them to use such name for their products; that the word Remington gives rise to a deception, inasmuch as the purchasing public may believe that only from the plaintiffs may they obtain articles coming from the famous works of the first manufacturer of typewriters.

The defendant thus moves to dismiss the complaint, and he also files his cross-complaint moving as follows:

a) To decree that the trademark Remington entered for the plaintiffs in the trade-register of the Imerial patent office be stricken out therefrom or that the plaintiffs be made to consent to such striking out.

b) To order the plaintiffs to acknowledge that they are not entitled to prohibit the defendant from carrying on the sale of machines made by the Remington-Sholes Typewriter Co., and their casings and covers marked with said business name nor from using said firm name in connection with advertisements or otherwise in the regular course of business.

To award immediate execution of the judgment on giving security.

Against the claim that the plaintiffs cannot by reason of this trademark prohibit the use of the proper name Remington for the goods of the Remington-Sholes Typewriter Co., the following points are made:

The name Remington contained in said business name

has been sneakingly appropriated, in order to unduly compete with the consignors of the plaintiffs; for Franklin Remington who joined said concern, had never theretofore constructed or sold any typewriter, nor had Carver Remington. In support hereof the plaintiffs refer to the affidavit of director C. W. Seamans at N. Y. and produce the affidavit of Thomas Richardson, dated June 23rd, 1896, of Silas W. Crandall, dated June 27, 1896, and of Clarence W. Seamans, dated Dec. 14th, 1895 (see translation record pp. 182-192, 194-196, 150-160). To these documents reference is made.

As regards the cross-complaint, as far as the same seeks to have the trademark of the plaintiffs stricken from the register, the plaintiffs state the following. They sell the machines of Wyckoff, Seamans & Benedict of N. Y. and at their instance have caused the word Remington to be registered as a trademark in connection with such sales, the manufacturers being legally entitled to affix said word to their manufactured articles. For the first typewriter factory has been conducted at New York under the name of E. Remington & Sons, they marked their products with the name Remington. This concern with its business name and all its rights has passed into the hands of the Standard Typewriter Mfg. Co.; the latter in consequence thereof changed its name to Remington Standard Typewriter Mfg. Co. and the last named concern with its business-name and all its rights finally passed into the hands of Wyckoff, Seamans & Benedict. This concern, therefore, has the right to mark its goods with the name Remington, it exercises this right in the U. S. and same has never been contested. In support of this contention the plaintiffs introduce an affidavit of Clark Seamans, dated Oct. 4, 1895 (pp. 38 and 39) of Wyckoff, Seamans & Benedict, dated Oct. 3rd, 1894 (P. 40) also the above mentioned affidavits of Clarence W. Seamans and Thos. Richardson, also the certificate of Judge Hardin of date Nov. 30, 1888 (pp. 104-106), the

affidavit of Elizabeth Remington (pp. 120-124), the certificates of registry by Benton J. Hall of date Oct. 23, 1888 (pp. 176-180) and by J. P. Fisher of date May 7, 1896 (p. 172.) Reference is had to all those documents.

The defendant contends that Franklin and Carver Remington have allowed the use of their names exclusively in connection with the Remington-Sholes Typewriter Co. He claims that Franklin Remington together with Zalmon Sholes have invented the typewriter named after them, that they started the company and took an active interest in its business; Franklin Remington is manager of the factory, whereas Carver Remington is only financially interested. As to the alleged right of Wyckoff, Seamans & Benedict to use the mark Remington it is insisted that they never acquired that right from any member of the Remington family, although they obtained the rights in the business-name of the Standard Typewriter Co. from the parent of Franklin and Carver Remington.

In the court below, by judgment of Kammer 4 fur Handelssachen des kgl. Landgerichts 1 of March 19, 1897 the cross-complaint was dismissed and judgment was rendered against the defendant in manner and form as demanded by the plaintiffs. As regards the facts, so far as not above stated, reference is made to the finding of facts in said judgment.

As ground of the above decision it is stated that it appears from the allegation of the parties that the defendant's motion to strike the trademark from the register is improper, because Wyckoff, Seamans & Benedict have the right to use that mark for their manufactured products. The decree against the defendant is based on the trademark protection due the plaintiffs, the defendant cannot avail himself of S. 13 of the trademark act, because being the general agent of Remington-Sholes Typewriter Co. it is not competent for him to enforce the rights in that business name on its own behalf.

The defendant has entered his appeal from said decree of April 15, 1897, on the 20th of April, 1897, and moves to modify said decree so as to dismiss the complaint and to find against the plaintiffs and cross-defendants according to the prayer of the cross-complaint. The defendant considers the reasoning of the first decision bad. If the defendant, though only the agent of the Remington-Sholes Co., can properly be sued, he may also avail himself of the provisions of the law beneficial to his principals. According to S. 13 of the act the plaintiffs case must fail because the machines bear only the names of the said Company. As to the cross-complaint, the statement contained in the opinion that the defendant has admitted, that the plaintiffs or their successors had acquired the business-name and right from a member of the Remington family, is incorrect, for the defendant has disputed this very point and so it appears in the statement of fact in said judgment. Defendant refers to the affidavits of Franklin and Carver Remington at Chicago to show that no member of the Remington family has ever granted the right to Wyckoff, Seamans & Benedict to use the name Remington in the course of business. The motion to strike the trademark of the plaintiffs from the register is, therefore, according to S. 9 of the act just.

The plaintiffs move that the appeal be dismissed. They argue several legal points in support of this motion. The statement by the defendant that he has only acted as the agent of the Remington-Sholes Co. they seek to contradict by a letter of Attorney Meissner of June 16, also by statements in the brief of the defendant of May 13, 1897 (record, vol. II P. 24 *et sec.*), as both documents speak of "the business of the defendant."

OPINION.

1. If that petition of cross-complaint which has for its object the cancellation of the trademark Remington registered for the plaintiffs must be granted, then the decision must be given, without further consideration against the plaintiffs. If this is the case, according to Sec. 12, sub sec. 2, of the act of May 12, 1894, as to trademark rights, the plaintiffs cannot now, nor against any previous infringement, exercise their right to an injunction. Therefore, it is first to be considered, whether or not, this part of the cross-complaint is well founded.

The motion to strike from the register is based on S. 9 of the act; in support thereof it is contended that the contents of the plaintiffs trademark Remington do not accord with actual facts and give rise to a deception. The competency of the defendant to bring this complaint to strike from the register, against the plaintiffs as the registered owners of said trademark, cannot, in the light of S. 9, be subject to any doubt. According to S. 9, No. 3, anybody may in a case like this, appear as plaintiffs, because the interests of the public require the nullification of deceptive trademarks.

But he who brings such nullification suit is bound to prove actual ground, in order to sustain it; he must allege and prove facts and circumstances, from which it must appear both that the trademark is repugnant to actual facts and also that its contents create a danger of deception. The facts alleged by the defendant do not justify these conclusions.

The defendant is correct in his contention that a trademark, which consists simply of a proper name, may be repugnant to actual facts. For the mark has direct reference to certain specified articles, it is intended to signify them as the articles of a definite concern. If a proper name is chosen, which to the purchasing public or the com-

mercial world generally suggests the inventor or producer of particularly useful and meritorious articles, the use of such proper name as a trademark to signify articles of a different producer or seller, may indeed conflict with actual facts.

The trademark Remington chosen by the plaintiffs is undoubtedly a proper name; a bearer of that name was the first one to construct typewriters adapted for practical use, the idea of practical typewriters is closely associated with that name. The plaintiffs Glogowski & Co. as proprietors of that trademark are not *personally* entitled to the use of that name. However it is incontestable, that the plaintiffs deal exclusively in the products of the American house of Wyckoff, Seamans & Benedict and that with a view to that business and with reference to the products of that house, they have caused the trademark to be entered in the register. If, therefore, the name Remington may be used as a trademark for those products without violating actual facts, then, in the case at bar, the idea of a deceptive trademark must be eliminated. In order to prove that these articles may lawfully be marked with the name Remington the plaintiffs allege that their manufacturers Wyckoff, Seamans & Benedict, are the immediate successors of that typewriter concern, which under the firm name and style of Remington & Sons was run by the first manufacturer, Samuel Remington. Among the numerous documents which the plaintiffs have introduced in support of their allegation as to that succession, the following are, under S. 403 Civil Code, considered competent evidence.

Three certificates numbered 1043, 1044 and 1045 respectively under the hand of Secretary of State, Richard C. Olney, of date March 11, 1896 (see translations pp. 171-175, 102-107 and 176-181 of record).

Two certificates, under the hand of Secretary of State Palmer, dated Feb. 29th, 1896 and April 23rd, 1896 re-

spectively (see translations pp. 164-168, and 128-140 record).

By these documents it is certified to that the Standard Typewriter Manufacturing Company has caused the word Remington to be entered as its trademark for typewriters in the trademark register at New York on Oct. 23rd, 1888, their predecessors E. Remington & Sons having marked their products with that word ever since 1880; said Company changed its name on Nov. 30, 1888, to Remington Standard Typewriter Manufacturing Company; the latter has become merged in the concern of Wyckoff-Seamans & Benedict, having assigned to said concern all its rights, titles, and interests, particularly also said registered trademark.

Under these circumstances it cannot be assumed that the use of the word Remington as a trademark for the typewriters manufactured by Wyckoff-Seamans & Benedict conflicts with actual facts. This word was intended as a suggestion that said concern has become the successor of the first manufacturing concern of Remington & Sons and continued to produce and sell machines which were made by said Remington & Sons under the same name. The defendant has not shown that these facts have been incorrectly stated by the plaintiffs. He states himself that Wyckoff, Seamans & Benedict acquired at the time from the father of the Remingtons the business-name and right of the Standard Typewriter Company. Their continuing to mark the products with the old name of Remington and causing said word to be protected as their trademark, does not violate actual facts.

It is true, the defendant contends that the Standard Typewriter Company never acquired the right to incorporate the name Remington into its business-name or to register a trademark containing that name, from the Remington family, or any member thereof, nor that any member of the Remington family has given that right to Wyc-

koff, Seamans & Benedict; in support of this contention the defendant refers to the brothers Franklin and Carver Remington at Chicago. These proofs, though they might otherwise have great weight, appear, however, irrelevant in view of the fact, that for the last nine years the Standard Typewriter Company has used the word Remington in its business-name without any molestation and that for the same space of time it has used the trademark Remington. For if Wyckoff, Seamans & Benedict have become the final successors of the old house of Remington & Sons and continue to manufacture and sell their product, then the old name Remington as a mark on such products cannot be regarded as intrinsically correct, although the members of the Remington family have not given their consent to the use of that name.

The facts cited by the American house of Wyckoff, Seamans & Benedict in support of their right to use the name Remington, may, however, avail the plaintiffs as well, if the question to be settled is whether the trademark conflicts with actual facts; for here we have to consider the name of an American manufacturer and also the articles obtained by the plaintiff from the United States; if the latter, without violating actual facts, may be marked with the name Remington in the United States, then it cannot be assumed that the same name used for the same product violates actual facts in this locality. At any rate, the defendant has not supplied the necessary proofs tending in that direction.

Nor has it been shown, that the adoption of the word Remington for the articles of the plaintiffs, creates any danger of deception. It would have been incumbent on the defendant to show, that the article sold by the plaintiffs under that trademark is not identical with the one which is suggested to the commercial world and the purchasing public by the name Remington; for in order that the motion to nullify may be sustained, the contents of the trademark

must, under S. 9 No. 3 of the act, be so deceptive, as to cause mistake regarding the kind and quality of the article. In this respect the defendant has failed to show any tangible grounds to support his motion to nullify.

These considerations have led us to conclude that the cross-complaint, so far as it seeks to have the trademark of the plaintiffs annulled, must be dismissed.

2. The complaint and the cross-complaint (*b*) bear such relation to each other, that if the complaint can be sustained, the cross-complaint must be dismissed and *vice versa*.

In deciding these matters we must start from the premise, that the articles which the defendant sells in this locality, are manufactured by the American house of Remington-Sholes Typewriter Co. at Chicago. Marked with the name of that house, they are introduced by the defendant into commerce, and that name may also be found upon the announcements and advertisements of the defendant. The plaintiffs take the position that by virtue of their trademark rights they may enjoin the Remington-Sholes Typewriter Co. from the use of that name. For two reasons this position cannot be regarded as sound.

In the first place, under SS. 12 and 20 of the act of May 12th, 1894, only such use of a registered trademark can be denied to third persons, as may cause mistakes or confusion about commercial articles; if under the existing facts, such danger is out of the question, then there can be no infringement of the trademark. This principle must be particularly adhered to in the case of a single word used as a trademark. After such a word has been registered its use in commercial life is not necessarily to be condemned, but such use is only so far improper as it may give rise to the possibility of a mistake or deception. According to this principle, the plaintiffs cannot, in the case at bar, be granted the right to enjoin the defendant for their trademark consisting of the one word Remington, cannot be con-

fused with the appellation "Remington-Sholes Typewriter Company," even by purchasers that would not pay attention to the particulars of the trademark. This is not an insignificant distinction, one that would but little effect the total impression produced by the trademark but a material and striking difference barring all danger of a mistake.

In the second place, the defendant to defeat whatever rights the plaintiffs may have to an injunction, may properly avail himself of the saving clause in S. 13 of the act of May 12, 1894.

The court below denied to the defendant, as the general agent of the Remington-Sholes Typewriter Co. at Chicago, the right to enforce the protection of this trademark. We are unable to sustain this decision. No matter whether the defendant—as he himself alleges—is an employe of said American house or—as the plaintiffs say—he does business on his own account; in either event it is competent for him to use, in Germany, the American business-name in connection with the goods of the American concern in which he deals exclusively. In the first place such trademark protection may be derived from S. 23 subsec. 1, of the act. According to the proclamation of the Chancellor of Sept. 22, 1894 (see Reichsgesetzblatt P. 521) the same protection is granted to German trademarks in the United States as to American ones; therefore the protection of the law of May 12, 1894 extends likewise to American concerns, that have no branch in this locality. This protection must, without discrimination, extend to all the goods of the American house which are offered for sale in Germany, although there is no branch of said foreign house here; from this it follows that American goods which are offered for sale here upon commission or by merchants on their own account, are entitled to the same protection. The protection of the act of May 12, 1894 which is guaranteed by S. 23, subsec. 1, extends likewise to the right mentioned in S. 13, to affix the business name and information about the manner and

place of production, on goods, on their covers and to use them in the course of business. Accordingly, the defendant, who in this locality sells the typewriters of the Remington-Sholes Typewriter Co. of Chicago cannot be prohibited from affixing said business name upon the goods of said house nor from using it in the course of business, or announcements, advertisements, etc. It is not open to dispute, that the defendant deals only in typewriters made by said concern, and that he actually obtains his goods from said concern.

The plaintiffs have tried to establish that the Remington-Sholes Typewriter Co. has unlawfully and sneakingly appropriated the word Remington. They do not dispute that two descendants of the typewriter manufacturer Remington, Franklin and Carver Remington, were among the founders of the concern and are still interested in the same; but again they claim that Franklin and Carver Remington entered into said concern only pro forma, to bestow upon it an apparent right to use their name so well known in this line of business. However, whatever the plaintiffs have actually shown by way of foundation to their opposition to the use of the name Remington can in no wise give rise to the conclusion, that in this instance a business name has been sneakingly appropriated. The plaintiffs have confined themselves to the following statements: Franklin and Carver Remington are the sons of Samuel Remington, one of the copartners of the old firm of Remington & Sons; neither of them has ever had anything to do with the running of the business of said firm, or, before entering into the present business under the name of Remington-Sholes Typewriter Co. ever occupied himself with the manufacture of typewriters. But even if both these points had been fully established, it would not result therefrom, that the two Remingtons would not become real associates in said new house and were only pro forma engaged by said house, that their name might be used for improper purposes. For

it is quite possible, yea even probable, that they should have seriously devoted themselves to the business of their father, and acquired special knowledge, in which they were formerly lacking. To choose this business, in order to take advantage of the reputation attached to their name in this line of business, they have a perfect and indisputable right.

The motion of the plaintiffs for the taking of deposition of the manufacturer Seamans as to the above stated allegations of fact, is, therefore, denied. But if the plaintiff's objections to the right to use the business name of the Remington-Sholes Typewriter Co. must be overruled, they cannot, according to the above reasoning, be conceded the right sought by their complaint of enjoining the defendant; it follows from the dismissal of the complaint that a decree be entered against the plaintiffs granting the prayer of the cross-complaint (*b*) referring to the acknowledgment of the defendant's right, to use in the course of business the name Remington-Sholes Typewriter Co. as a trademark for the goods manufactured by them.

The decision as to the costs of suit rests on S. 88 Civil Code.

(signed) Busch, Rabe, Nehse, Kuhler
also for District Judge Dellbruck who is no longer a member of the "Kammergericht."

Promulgated.
Berlin the 15 October 1897.

(signed) Mittelstadt
(Seal of the Court) Court Clerk of the
"10 Civilsenats des Konigliche
Kammergerichts."

Opinion of the German Reichsgericht.

In the Name of the Empire.

In the case of the firm, Glogowski & Co. of Berlin, plaintiff and revision plaintiff, represented by counsel, Patzki of Leipzig,

against

Henry Newald, Merchant, of Berlin, defendant and revision defendant, represented by counsel, Sachs of Leipzig.

The "Reichsgericht, (Supreme Court) zweiter Civilsenat," by the concurrence of the President, Dr. Binger and the "Reichgerichtsrathe," (Supreme Justices) Wielandt, Dr. Petersen, Rospatt, Fortsch, Remele, Petrey, at the oral hearing of Mar. 4, 1898 have handed down the decision:—

With regard to the judgment of the "zehnten Civilsenats des Koniglich Preussischen Kammergerichts," at Berlin of July 3, 1897, the following revision is remanded, the costs of the court of revision are placed upon the revision plaintiff.

"Von Rechts Wegen" (By reason of the law).

Statement of Facts.

The firm Glogowski, plaintiffs, are engaged in Berlin in the business of dealing in American typewriters, which they obtain from the firm Wyckoff, Seamans & Benedict at New York. They allege, that these sales are carried on in their own name and for their own account, while the merchant Newald, defendant, claims, that they sell the machines simply as agents of the American firm.

On February 8, 1896, the word "Remington," was entered as a Trade-Mark, in the Imperial Patent Office at Berlin, and on behalf of the predecessors of the plaintiffs,

Glogowski and Son; said Trade-Mark is intended for typewriters and their parts, also for typewriter supplies; the line of business in which the mark is to be used, is said to be "The sale of the aforementioned articles." This Trade-Mark has been assigned to the plaintiff firm.

The defendant carries on at Berlin the sale of American typewriters of the firm, Remington-Sholes Typewriter Co. at Chicago. He himself states, that he carries on such sales as the employe of said concern and on its account. The plaintiff, against this, maintains that he carries on an independent business in his own name. The typewriters of said American concern introduced into commerce by the defendant, are marked with the full name of said concern, this firm's name is likewise printed in the advertisements and price lists of the defendant.

The plaintiff believes that the defendant, in carrying on such business, violates their trademark rights and moved for a judgment, as follows:—

a: That the defendant, on pain of fine to be imposed for each case of violation, refrain from placing the word "Remington," either singly or in connection with other words, upon any typewriter, casings or enclosures therefor, and from using such marks in connection with any advertisements, price lists, letters, recommendations, bills and the like.

b: That the defendant remove the mark "Remington" from all typewriters, price lists, letters of recommendation and other printed matter in his possession, or in case such removal cannot be effected in any other way, then destroy all typewriters and articles bearing the aforesaid mark.

The defendant raised the objection to the complaint that he is incompetent to be sued, since he does not sell here in his own name, but as the employe of the Remington-Sholes Typewriter Co.

The defendant further replied that he has a right to use, in connection with typewriters consigned by said concern,

the business name containing the word "Remington;" that said word is a proper name, and two bearers of this name, Franklin Remington and Carver Remington are associated with and interested in this firm; that they are descendants of the first manufacturer of typewriters, Samuel Remington; that years ago they had associated themselves with Zalmon Sholes in a concern for the manufacture of typewriters under a business name containing the words Remington and Sholes; that this concern has produced a typewriter wholly different from previous constructions; that, for many years, they have been selling these machines all over the world under said business name, and that its right to place such business name upon its machines has never yet been contested.

The defendant moved to dismiss the complaint; maintained that the plaintiff, under Sec. 9 of the law of May 12, 1894, was not properly entitled to the trademark Remington; and filed a cross-complaint and moved, as follows:—

a) to decree that the trademark Remington, registered for the plaintiff be cancelled.

b) to order the plaintiff to acknowledge that they are not entitled to prohibit the defendant from carrying on the sale of the machines made by the Remington-Sholes Typewriter Co. their casings and enclosures, which are marked with said business name, nor from using said firm name in connection with advertisements or otherwise in the regular course of business.

The "Konigliche Landgericht I," (territorial court) at Berlin, upon Mar. 9, 1897 decided against the defendant in accordance with the complaint, and the cross-complaint was dismissed as unfounded. Upon the appeal of the defendant, the "Konigliche Kammerigericht" (Supreme Court) at Berlin, by the judgment of July 3, 1897, upon which the review is taken, decided that:—

1. the prayer of the plaintiffs was refused.

2. a degree entered against the plaintiffs in accordance with the prayer (*b*) of the cross-complaint; the prayer (*a*) of the cross-complaint was refused; the costs of court were equally divided between the parties, the other costs of the parties were set-off against one another.

In the decision, it is stated, that that prayer of the cross-complaint, which has for its object the cancellation of the trademark registered for the plaintiff, is not well founded, and then continuing:

> "the complaint and the cross-complaint (*b*) are so related, that if the complaint can be sustained, the cross-complaint must be denied and *vice versa*.
>
> "In deciding these matters, we must note that the articles which the defendant sells in this locality, are manufactured by the American concern, Remington-Sholes Typewriter Co. at Chicago. Marked with the name of that concern, they are introduced by the defendant into commerce, and that name may also be found upon the business advertisements of the defendant. The plaintiff believes, that by reason of their trademark rights, they may enjoin the use of that firm name. This position of the plaintiff can not be regarded as sound, for two reasons.
>
> "First, under Sec's 12 and 20 of the act of May 12, 1894, only such use of a registered trademark can be denied to third persons, as may cause mistakes or confusion about commercial articles; if under the existing facts, such danger is out of the question, there can be no infringement of the trademark. This principle must be particularly adhered to in the case of a single word used as a trademark. After such a word has been registered, its use in commerce in all cases is not to be condemned, but is only so far improper as it gives rise to the possibility of a mistake or deception. According to this principle, the injunction cannot be granted to the plaintiff in the present case, for their trademark consisting of the single word Remington, can not be confused with the appellation 'Remington-Sholes Typewriter Co.' either by the trade or by the purchasing public, that does not give attention to the particulars of the trademark. This is not an insignificant distinction, one that would have little

effect upon the total impression produced by the trade-mark, but a materially different appearance is presented to the eye, barring all danger of mistake.

" In the second place, the defendant to defeat whatever rights the plaintiff may have to an injunction, may properly avail himself of the restriction of Sec. 13 of the act of May 12, 1894.

" The court below refused to permit the defendant, as the general agent of the Remington-Sholes Typewriter Co. at Chicago, to maintain the right to the use of this trade-name. We are unable to sustain the decision. It is immaterial whether the defendant—as he himself alleges—is an employe of said American concern, or—as the plaintiff states—he does business on his own account; in either event, he may use, in Germany, the American trade-name in connection with the goods of the American concern, in which he deals exclusively. In the first place, such trademark protection may be derived from Sec. 23, Subsec. 1, of the act. According to the proclamation of the Chancellor of Sept. 22, 1894 (see Reichsgesetzblatt P. 521) the same protection is granted to German trademarks in the United States as to American ones; therefore, American concerns, that have not branches here, share, to the full extent, the protection of the law of May 12, 1894. This protection must extend, without discrimination, to all the goods of the American concern offered for sale in Germany, although there is no branch of said American house here; from this it follows, that American goods which are offered for sale here upon commission or by merchants on their own account, are entitled to the same protection. The protection of the act of May 12, 1894, which is guaranteed by Sec. 23 Subsec. 1, extends likewise to the right mentioned in Sec. 13, to affix the business name and information about the manner and place of production on goods, on their enclosures, and to use the same in the course of business. Accordingly, the defendant, who offers for sale here, the typewriters of the Remington-Sholes Typewriter Co. of Chicago, can not be prohibited from affixing said business name upon the goods of said house nor from using it in the course of business, upon advertisements, etc. It is not open to dispute, that the defendant deals only in typewriters made by said concern, and that he actually obtains his goods from said concern.

> "The plaintiffs have tried to establish that the Remington-Sholes Typewriter Co. has unlawfully and surreptitiously appropriated the word Remington. They do not dispute that two descendants of the first typewriter manufacturer Remington, namely, Franklin and Carver Remington, were among the founders of the concern and are still interested in the same, but they claim that both these individuals named, entered into the concern only pro forma, to bestow upon it an apparent right to use their name so well-known in this line of business. However, whatever the plaintiffs have actually shown by way of foundation for their opposition to the use of the name Remington, it can in no way give rise to the conclusion, that in this instance a business name has been surreptitiously appropriated."

From this judgment the plaintiffs have asked for a revision, and move that the same be revoked as far as the appeal of the defendant is concerned, and that the judgment in the first instance be reinstated by rejecting such appeal.

The defendant has moved that the revision be refused.

Opinion.

The revision can have no effect.

The judgment which is attacked gives two substantial reasons for its decision. The first set forth therein, that the danger of a confusion in business of the trademark employed by the defendant is not apparent, when compared with the plaintiff's trademark; the plaintiff is therefore not entitled under Sec's 12 and 20 of the act of May 12, 1894, to enjoin the defendant's use of his trademark.

This reason depends upon a finding of facts which may not be examined in the court of review, and is in itself alone sufficient to support the decision.

In this connection, as a reason for a revision of the judgment, the point is made, that the appellate court only considered, in its decision, the right to use a certain firm name, which right is governed by special principles, while

the review itself is only concerned with the protection of trademarks as regulated by the act of May 12, 1894. This presentation is, however, not well founded and is based upon an incorrect understanding of the opinion rendered. In the case at bar, of course, the trademark and the marking of the firm name are in the same category. But the opinion clearly shows, that the trademark as such, and in accordance with the declaration of the act of May 12, 1894, is made the subject-matter of the decision.

After so holding, it is not necessary to consider the second reason given by the appellate court for its decision, nor to consider, in this connection the reason given for a revision of the decision.

The burden of the costs of the court of revision is placed upon the review-plaintiff in accordance with Sec. 98 of the Civil Code.

(Signed) Dr. Binger, Wielandt, Dr. Petersen,
Rospatt, Fortsch, Remele,
Petry.

Rendered at the public session of the "zweiten Civilsenats des Reighsgerichts," (Supreme Court) upon Mar. 4, 1898.

Signed, Schrader,
Clerk of the Court.

Promulgated at Berlin, October 2, 1899,
(L. S.) Subscribed
Clerk of the Court of the
"Landgerichts I, 4, Kammer fur Handelssachen."

Be it known, that I certify to the literal agreement of the foregoing copy with the promulgation of the "Koniglichen Landgerichts I," Berlin of October 2, 1899.

Berlin, Oct. 6, 1899,
(L. S.) Rudolf Meissner,
Notary Public.

CONSULATE-GENERAL OF THE UNITED STATES OF AMERICA, CITY OF BERLIN, KINGDOM OF PRUSSIA, GERMAN EMPIRE. } ss.

I, Frank H. Mason, Consul-General of the United States of America at Berlin, Germany, do certify that Rudolph Meissner whose signature is subscribed to the foregoing instrument, was, at the time of subscribing the same, Notary Public of the Royal Prussian Court of Justice at Berlin, Empire of Germany, duly commissioned and by law authorized to execute such acts, and that his signature and seal of office affixed thereto are genuine, and as such are entitled to full faith and credit.

WITNESS my signature and seal of office, at Berlin, this 3rd day of January in the year 1901.

FRANK H. MASON,
U. S. Consul-General.

(L. S.)

EXHIBIT B.

(Opinion of United States Circuit Court.)

UNITED STATES CIRCUIT COURT, DISTRICT OF VERMONT.

Wyckoff, Seamans & Benedict
vs.
The Howe Scale Co., of 1886. } In Equity.

E. Remington & Sons a corporation of New York of 1865 made and sold fire-arms; it began to make and sell typewriters as a branch of its business in 1873, which became well and favorably known and were marked as Remington machines. The plaintiff, then a partnership now a corporation, of New York became the selling agent of these typewriters which were largely advertised and introduced by that name in this and foreign countries, and acquired and maintained a good reputation for style and workmanship. In 1886 the plaintiff bought out the typewriter business, including franchises and trade-marks and has continued and largely increased the manufacture and sale of the Remington machines by that name.

In 1893 Zalmon G. Sholes, got up a machine called the "Z. G. Sholes" typewriter, and a corporation of Illinois was organized to make and sell it, called the Z. G. Sholes Company. Carver Remington and Franklin Remington of Chicago acquired an interest in the corporation and business and the name of the machine was changed to "Remington-Sholes," and in 1894 the name of the corporation was changed to "Remington-Sholes Typewriter Company." This company has made, advertised and ex-

tensively sold those machines in this and foreign countries by the name "Remington-Sholes" in full, or "Rem-Sho," an abbreviation of it, and placed one or the other prominently upon the machines.

The defendant the Howe Scale Co. of 1886 is a corporation of Vermont, and has been and is a sales agent of these machines to a large extent for the Remington-Sholes Co. and so has prominently participated in this use of the name Remington, and this abbreviation of it in this business in this manner.

This suit is brought for that participation; the defendant justifies under the Remington-Sholes Co. and that company has assumed the defence of the suit and the validity of the defence depends upon the right of that company to so take and use the name "Remington" upon its machines.

Several questions in the case have been made by motion to suppress evidence and have been brought into the final hearing. They relate principally to testimony taken in rebuttal as not properly such; to testimony as to the use of the name in business correspondence and transactions not shown to have emanated from the defendants; and to testimony showing the use of the name upon, and in connection with the sale of typewriters in foreign countries.

Perhaps some of the testimony taken in rebuttal is not strictly such, but is rather cumulative; still it is such as would be admissible if taken at the proper time, or with leave, and as the motion has been brought along by consent to the hearing in chief, and the testimony might be the subject of a motion to retake, without intending to relax the rule as to order it is deemed best under the circumstances that this testimony be left to stand for what it is worth.

The evidence relates to machines emanating from the party under whom defendant has acted and justifies, with the name in question upon them, as placed there by that party, and evidence as to transactions in respect to such machines in connection with and relation to the plaintiff's machines and names, in trade although not proceeding directly from that party, or from the defendant, or authorized by either, appears to be admissible as a part of the *res gestae* for the purpose of showing the effect upon the plaintiff's trade of putting these other machines into the markets with the names in question upon them.

As this is a suit for interference in trade the boundaries of the dealing and not of governments or countries is material. There is said to be a difference between the laws of this country and those of some of the countries in question; but the laws of those countries would not govern or vary the rights of parties here in respect to transactions emanating from here, although carried out there. The motion to suppress is therefore overruled.

The intricate and delicate machinery of typewriters requires good materials and nice workmanship and their reputation depends largely upon the quality of their manufacture. The Remington Typewriter was among the pioneers, and one of the foremost in reputation for good construction. That the introduction to the markets of another machine with that name upon it, at the time when the Remington-Sholes machine appeared, would make confusion in the plaintiff's trade, and tend to pass off the new machines for the regular Remington machines of the plaintiff needs no proof but the circumstances; that it actually did have that effect well appears from the evidence. That was what the taking of the name was calculated to do, and what was to be expected. The ultimate purchasers would be led to think that the

addition of the name "Sholes" was a new style of the old machine coming from the same source.

Upon the well established principles that one has no right to push his wares as those of another, this would ordinarily be an actionable wrong at law, repetition of which to save multiplicity of suits for repeated wrongs would be restrainable in equity.

That these Remingtons are descendants of one of the original Remingtons, and Sholes a descendant of an inventor of some part of the original typewriters, is set up and relied upon as establishing a right to the use made of the names "Remington-Sholes" in this connection. No right descended however in these respects from any of these ancestors, to any of these persons; and this excuse has no legal foundation but is entirely sentimental. They were situated as to this as any other persons of the same names would have been, with no standing but their own natural rights to the use of their own names in the transaction of their business.

That all persons have respectively, the right to use their own names in their own business is entirely clear; but this right is subject to the limitation common to all rights that it is to be so used as not to injure the rights of others.

These Remingtons were not themselves manufacturers of typewriters, and did not start in as nor become such in their own names, nor have their own names put upon machines of their own make; but they gave their name to a large corporation as a distinct entity, which took the name into the typewriter business and put it upon the machines of that corporation whereby they undertook to confer the right to the use of that name upon that entity for the benefit of others, who had no right to use it at all. This was not a legitimate exercise of the natural

right to use their own name in their own business; but was an attempt to exercise a fictitious right to use the name in, to a great part, others' business. This was going far beyond their own rights, and was an undertaking to give what they did not have; and their own natural right to the use of their own name in their own business became thereby so mingled with the unlawful use of it for the benefit of others that it is indistinguishable here. They lost their identity in that of the corporations.

Connecting the name "Sholes" with Remington, in the business and on the machines would not or might not adequately indicate to a purchaser who had known or heard of the Remington typewriters, and wanted one, that these were not original Remingtons such as were wanted. The name although linked with Sholes, would indicate Remington connection in typewriter production and imply the original manufacture.

This use of the name "Remington," although done in such connection appears to be an unjustifiable invasion of the right to that name belonging to the plaintiff.

The long name Remington-Sholes, got shortened into Rem-Sho, in writing and speech in conducting the defendant's business which was well understood to be an abbreviation of the full name. The defendant has put the abbreviation upon the machines in place of the full name; and claims that this, at least, is so different from the name Remington as used by the plaintiff, and its predecessors that it can, and does, not to amount to any representation that the machines are Remington machines. If this short name had been the one first used there would be much plausibility in this argument; but following Remington-Sholes as it has in use it has become a well known short representation of what the long name it

stands for represented, and of itself now amounts to a wrongful representation of the source of the defendant's machines.

According to these views the plaintiff appears to be entitled to a decree suppressing the use of the name Remington in the compound name of "Remington-Sholes," and the use of the compound abbreviation of that name upon the defendant's typewriting machines or in the sale thereof.

Decree for plaintiff.

HOYT H. WHEELER.

WILDER L. BURNAP,
H. D. DONNELLY,
CHARLES E. MITCHELL,
for plaintiff.
BUTLER & MOLONEY,
JAMES H. PEIRCE,
GEORGE P. FISHER, JR.,
for defendant.

EXHIBIT C.

(Decree of United States Circuit Court.)

At an Equity Term of the Circuit Court of the United States in and for the District of Vermont, held at Windsor, in said District on the 3rd Tuesday of May and on the 14th day of August, a day in said term 1901.

Present: Hon. HOYT H. WHEELER, Judge.

UNITED STATES CIRCUIT COURT, DISTRICT OF VERMONT.

Wyckoff, Seamans & Benedict,
vs.
The Howe Scale Company of 1886. } In Equity.

This cause coming on to be heard upon the pleadings and proof and after hearing Messrs. Henry D. Donnelly and Charles E. Mitchell, counsel for the complainant, and James H. Peirce and George P. Fisher, Jr., counsel for the defendant, and due deliberation having been had thereon, it is ordered, adjudged and decreed, and the court doth hereby order, adjudge and decree as follows, namely:

1. That since about the year 1873 the complainant and its predecessors have been engaged in the manufacture and sale of Typewriting Machines which became well and favorably known, and were marked and designated as "Remington" machines.

2. That said writing machines were put upon the market by complainant and its predecessors and introduced advertised for sale and popularized in this country

and in foreign countries under the name of "Remington" and "Remington Typewriter," by which names they came to be widely known and identified by purchasers and the public, and which before the acts of the defendant and its principal "Remington-Sholes Company" in the bill of complaint mentioned had for many years been continuously and exclusively used to designate and identify complainant's machines.

3. That prior to the acts complained of the complainant acquired and succeeded to the typewriter business founded by E. Remington & Sons, including franchises, trade-marks and the good will thereof, and said business of manufacturing and selling typewriting machines was continued and largely increased and an important good will was created and existed which was a source of great profits to complainants.

4. That the defendant, Howe Scale Company of 1886, a corporation existing under the laws of the State of Vermont, has made use, in connection with the sale of typewriting machines manufactured by the Remington-Sholes Company a corporation existing under the laws of the State of Illinois of the name and designation "Remington-Sholes" and "Rem-Sho," and has sold and caused the typewriting machines of said "Remington-Sholes Company," to be advertised for sale and to be offered for sale and sold and delivered, by word of mouth and otherwise, under the name of "Remington-Sholes" typewriters and "Rem-Sho" typewriters.

5. That the sale by the defendant, "Howe Scale Company of 1886," of typewriting machines manufactured by or for the said "Remington-Sholes Company" under the name of or as "Remington-Sholes" typewriters or "Rem-Sho" typewriters, constitutes a fraudulent infringement and invasion of the rights of the complainant

and an unfair and inequitable competition which equity will restrain.

6. That at the time this action was commenced the defendant, "Howe Scale Company of 1886" was the general sales agent of the "Remington-Sholes Company" for the United States and that said last named company assumed the defence of this action, agreed to pay and has paid all expenses incident to the defence thereof, and agreed to protect and save harmless said defendant with respect thereto.

7. And it not appearing that the defendant as such agent has received any profits, gains and advantages which have arisen or accrued to it from the infringement of the said trade-name and designation "Remington" by using or selling typewriting machines having thereon the name "Remington" or the abbreviation "Rem" as the name or part of the name of said writing machines, and an account thereof is denied without prejudice to any right of the complainant to recover the same of the principal the Remington-Sholes Company.

8. And it is further ordered, adjudged and decreed that an injunction be forthwith issued herein perpetually enjoining the defendant, "Howe Scale Company of 1886" its officers, clerks, attorneys, agents, servants and workmen and all persons acting in privity with it or them or claiming through or under it or them from in any manner whatsoever making use of the designation "Remington" or "Rem" as the name or part of the name of any typewriting machine whatsoever manufactured by said Remington-Sholes Company, or by defendant or any person or concern and from selling, offering exposing or advertising for sale by means of signs, show cards, catalogues, circulars, publications, advertisements or by word

of mouth, or in any manner whatsoever, typewriting machines manufactured by said "Remington-Sholes Company" or by defendant or any person or concern, under the name of or as "Remington-Sholes" or "Rem-Sho" or by any designation of which the word "Remington" or the abbreviation "Rem" shall constitute a part.

9. And it is further ordered, adjudged and decreed that an injunction be forthwith issued herein perpetually enjoining the said defendant, Howe Scale Company of 1886, its officers, clerks, attorneys, agents, servants and workmen, and all persons acting in privity with it or them or claiming through or under it or them from in any manner whatsoever making use of the word "Remington" or the abbreviation "Rem" as the whole or as a part of any name or designation whatsoever, which shall be marked upon, or affixed or applied, by any means to typewriting machines manufactured or sold by the said "Remington-Sholes Company" or by defendant or any person or concern and used by it or them in connection with the manufacture and sale of its or their writing machines and to distinguish and identify the same.

10. And it is further ordered, adjudged and decreed that the said complainant do recover of the defendant its costs, charges, and disbursements in this suit to be taxed by the Clerk of this Court, and that in default of the payment of the same the complainant have execution therefor.

HOYT H. WHEELER, Judge.

Clerk's Office, U. S. Circuit Court.
District of Vermont.
BURLINGTON, November 4, 1901.

I hereby certify that the above and foregoing is a true

copy of the original decree in case of *Wyckoff, Seamans & Benedict* v. *Howe Scale Co. of 1886*, now remaining on file in my office.

GEORGE E. JOHNSON,
Clerk.

[SEAL.]

EXHIBIT D.

(Opinions Rendered by United States Circuit Court of Appeals.)

UNITED STATES CIRCUIT COURT OF APPEALS, SECOND CIRCUIT.

Before WALLACE, LACOMBE AND COXE, Circuit Judges.

Wyckoff, Seamans & Benedict,
Complainant-Appellee,
vs.
The Howe Scale Company of 1886,
Defendant-Appellant.

This cause comes here upon appeal from a decree of the Circuit Court, District of Vermont granting an injunction against the use of the name Remington or its abbreviation "Rem" upon defendant's typewriting machines, or in the sale thereof. The nominal defendant is a sales agent only, the real defendant, which has assumed the defence of the suit, is the Remington-Sholes Company of Chicago, Illinois, and it will be understood that whenever the word "defendant" is used in this opinion it refers to the last-named corporation only.

LACOMBE, Circuit Judge.

The complainant is the successor of so much of the business of the corporation E. Remington & Sons, (which succeeded the old firm of the same name) of

Ilion, N. Y., as is concerned with the manufacture and sale of typewriters, including good-will, trade marks, etc. The old firm was organized into a corporation in 1865 and in 1873 it began the manufacture of typewriting machines. It is not disputed here that the firm and the corporation acquired a high and well deserved reputation for careful workmanship in every branch of manufacture which it undertook; nor is it disputed that the typewriting machines which the corporation and its successor have continuously manufactured at Ilion are most favorably known to the public and are associated in the public mind with the name Remington, so that the ordinary purchaser is quite likely to assume that a machine offered to him for sale as a "Remington" has come from the establishment founded by the Remingtons at Ilion nearly half-a-century ago. To this manufacture and trade the complainant succeeded in 1886; it thereupon became entitled to conduct the business of manufacturing machines and selling them as Remington machines, and would have the right to invoke the aid of a court of equity to restrain another trader from any action which would be calculated unnecessarily to confuse the goods of his own make with those of complainant.

The defendant is the Remington-Sholes Company, it marks its machines "Remington-Sholes" and "Rem-Sho" and there can be no doubt upon the record that the use of the name "Remington" helps the sale of machines and induces many purchasers to suppose that such machines are the product of the old establishment at Ilion. Defendant, however, insists that it has the right to use that name, because of its relations with two gentlemen of the name of Remington, that it has done nothing else to produce confusion and that, therefore, whatever confusion results is *damnum absque injuria*. We do not find in this voluminous

record sufficient evidence that defendant has itself done anything to promote confusion in the minds of the public, except to use the name Remington on its machines and in its literature. It may very well be that it understood quite clearly that by thus using the name defendant gave to all middlemen and dealers, outside of its own agents, opportunity and perhaps a suggestion to misrepresent the parentage of the machines, but, if it had the right to use the same, it cannot be held responsible for the consequences of such use. On the other hand if it had no right so to use the name it cannot avoid responsibility merely because its agents were careful to explain when selling to the trade that the Remington-Sholes machines were not the product of the original Remington establishment or of its successor. In such a case the question is "whether the defendants have or have not knowingly put into the hands of the retail dealers the means of deceiving the ultimate purchasers." *N. K. Fairbank Co.* v. *Bell*, 77 F. R. 869.

The question here is whether the name "Remington-Sholes" which is defendant's designation, and which therefore impregnates all the literature it circulates with the name which complainant's predecessors made a household word, was fairly bestowed upon it; and whether the same name was fairly placed on the machines.

The history of defendant's machines is as follows. In 1892 Zalmon G. Sholes (whose father had been an inventor of typewriters) invented a machine, constructed a working model of it and subsequently a second model, the first having been destroyed by fire. He called this "The Z. G. Sholes" typewriter and endeavored unsuccessfully to get sufficient capital to manufacture it for

sale. In 1893 he became acquainted with Franklin Remington and Carver Remington who were sons of Samuel Remington at one time president of the original corporation at Ilion. These junior Remingtons had not been themselves engaged in the manufacture of typewriting machines and at the time they met Sholes were engaged in some contracting work in Chicago, in connection with the drainage canal. In August 1893 they entered into an agreement with Sholes becoming jointly interested with him in the enterprise, and endeavored to interest capitalists, their own means being insufficient. In November 1893 the name of the machine was changed from "The Z. G. Sholes" to "Remington-Sholes," that is to say the name on the model was changed and the parties interested began to talk of the machine as the "Remington-Sholes," but no such machines had apparently been manufactured and offered for sale. In the spring of 1894, Mr. Head and Mr. Fay, two large capitalists became interested, and in May of that year a corporation was organized to manufacture and sell the machines. Of this corporation Franklin and Carver Remington were stockholders. Fay was the chief promoter, and received one-third of the capital stock as compensation for his services in organizing it. The name selected by its promoters for the corporation was "Remington-Sholes Typewriter Company." The new company leased a factory, bought tools and by December 1894 its first typewriting machine was placed upon the market. It was labelled "Remington-Sholes." This company continued to make and sell machines under that designation until it became financially embarrassed. Thereupon its stockholders, Remington, Fay, Head and others organized a new company, the present defendant "Remington-Sholes Co." to whom the entire assets of the old company was trans-

ferred through Fay, who held them and conducted the business for a brief interval. The new company devised the name "Rem-Sho" as a trade-mark of its machine, and marks upon the cross-bar of each machine the words "Remington-Sholes Company, Mfrs. Chicago." Manifestly the situation of the new company relatively to any issues raised here is substantially the same as that of the old company.

The principles of law governing cases of this kind are simple and easily stated; the only difficulty is their application. The Supreme Court in *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169 held that "Every one has the absolute right to use his own name honestly in his own business, even though he may incidentally interfere with and injure the business of another having the same name. In such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But, although he may thus use his name, he cannot resort to any artifice or to any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name. Where the name is one which has previously thereto come to indicate the source of manufacture of particular devices, the use of such name by another, unaccompanied with any precaution or indication, in itself amounts to an artifice calculated to produce the deception." No one may be excluded from taking up whatever business he chooses by the circumstance that some one else of the same name has made a reputation in it; nor may he be required to conduct such business under an alias although the conducting of it under his own name may produce a confusion in the public mind as to the identity of goods,

which no "precaution or indication" of his can effectually prevent. It is through no fault of his that his name happens to be the same as that of some other man who has already impressed his personality on some particular industry. All that is required of him is that he shall use reasonable precautions to prevent confusion, that he shall refrain from any affirmative act which may produce it; thus doing and thus refraining he may do business under the name that came to him without his choice and may call his goods by it, if he pleases. This may cause much injury to some one else, and some injury to the public, but no other rule could be adopted without injustice to the innocent individual, who is not responsible for the selection of his name. Unless the individual is to be debarred from one particular business altogether, or compelled to give up the name he inherited, the use of that name by two persons selling the same articles is a necessary evil to which the public must submit.

In the case of a corporation, however, the situation is different. The choice of its name is voluntary; such name is an artificial thing which can be selected by its incorporators from the entire vocabulary of names. In *R. W. Rogers Co.* v. *Wm. Rogers Man. Co.* 70 F. R. 1019 this court enunciated the proposition that "a body of associates who organize a corporation for manufacturing and selling a particular product are not lawfully entitled to employ as their corporate name in that business the name of one of their number when it appears that such name has been intentionally selected in order to compete with an established concern of the same name, engaged in similar business, and divert the latter's trade to themselves by confusing the identity of the products of both, and leading purchasers to buy those of one for

those of the other. . . . The corporators chose the name unnecessarily, and, having done so for the purpose of unfair competition, cannot be permitted to use it to the injury of the complainant." Other courts have laid down substantially the same doctrine *Higgins Co.* v. *Higgins Soap Co.* 144 N. Y. 462, *DeLong* v. *DeLong Co.* 89 Hun. 399, *Garrett* v. *T. H. Garrett & Co.* 78 F. R. 472, *LePage Co.* v. *Russia Cement Co.* 51 F. R. 941, *Clark Thread Co.* v. *Armitage* 67 F. R. 896, *Valentine Meat Juice Co.* v. *Valentine Extract Co.* 17 Patent & Trade Mark Cases 673. Moreover the incorporator who elects to transfer his own name for business purposes to an artificial person other than himself is taking an affirmative step in the direction of promoting unnecessary confusion, instead of taking precautions to prevent it.

The corporation defendant and its predecessor the typewriter company acquired their names by the selection of the individuals who organized them. Obviously there was no necessity that either of them should take the name "Remington" either alone or in combination. The junior Remingtons contributed money to the enterprise and gave, at least one of them did, time and services to its promotion, but they were very far from being the entire corporation; the corporation was a separate entity from them; they chose not to prosecute the typewriter business themselves; had they done so good faith toward those dealing with them might make it necessary to use their own name; they chose on the contrary to associate themselves with others in a corporation whose name its organizers were free to select. Some suggestion has been made that the machines existed before the incorporation; that they were produced by the Remingtons and Sholes individually at a time when the Remingtons had gone into the typewriting business with Sholes on their own

account and had a right to sell their goods under their own name. The record is very volunminous and we may have overlooked some item of proof, but a careful examination of it does not sustain this proposition. Prior to the formation of the Remington-Sholes Typewriter Company no machines had been sold or offered for sale. Two or more had been made as models and the name on them changed from "Z. G. Sholes" to "Remington-Sholes," but the new name had not become associated with the machine except in the talk of the future corporators among themselves; the public knew nothing of any such name in connection with a typewriter, indeed did not know the junior Remingtons or even Sholes as a producer of typewriters. No necessity, business or otherwise, required the selection of the name "Remington-Sholes" for the corporation. And when it was formed and began for the first time to make and sell machines, it was free to select any name it pleased to designate them. It chose its own name, but its choice was not like the choice of an individual who has inherited a name and applies it to his goods. If the name of the corporation was adopted unnecessarily and with the expectation that it would produce a confusion through which some trade intended for another might be diverted to itself, it would have no right to offer its goods under that name.

We have no doubt whatever that the name Remington was chosen because it was expected that it would naturally lead the public to suppose that the new corporation was either the successor or some branch of the old concern, of which appellant's brief observes: "the name Remington was admittedly a by-word for good workmanship the world over." There are some propositions that do not require direct affirmative testimony, and we do not gain much enlightenment from the long examina-

tion of Mr. Sholes as to what were his mental processes when he invented the combination "Remington-Sholes." Counsel for the appellee frankly conceded on the argument that the choice was an "intelligent" one. That is quite sufficient. We have no doubt it was an intelligent choice; those who selected it well-knew that the use of the name Remington in connection with a typewriting machine would help to sell it, as the name of Brown or Peterson would not. They knew too that it would be thus helpful because it suggested to the purchaser that it had been made by the Remington concern, whose name was a "by-word for good workmanship the world over." They knew that the presence of that name on the machine would be a constant temptation, often yielded to by whomever sold one to the uninstructed purchaser, to represent that it was the "real" or the "improved" Remington; that the presence of the name made confusion easy; and that the results of any confusion would be entirely in their favor. It was because of that knowledge that the Remington's associates, Sholes the sole inventor of the machine, and Fay the capitalist whose contributions enabled the new concern to manufacture on a scale large enough to bring it into the field as a competitor, selected the Remingtons' name, not because they were willing to pay some graceful compliment to Franklin Remington for the energy and enthusiasm with which he entered upon his new sphere of activity, or to himself and his brother for the $15,000. they invested in the enterprise.

Under the authorities in this circuit the complainant is entitled to the injunction granted him as to the use of the name "Remington." The arbitrary name "Rem-Sho," however, does not seem to us to be sufficiently like "Remington" to be by itself a reasonable cause of confusion. The decree, therefore, is reversed without costs and cause

remanded with instructions to decree in favor of complainant only as to the name "Remington."

UNITED STATES CIRCUIT COURT OF APPEALS, SECOND CIRCUIT.

Wyckoff, Seamans & Benedict,
Complainant-Appellee,
vs.
The Howe Scale Company,
Defendant-Appellant.

COXE, J.

I concur in the conclusion reached by Judge Lacombe for the reason that I am unable to distinguish this cause from *Rogers* v. *Rogers*, 70 Fed. Rep. 1017.

UNITED STATES CIRCUIT COURT OF APPEALS, SECOND CIRCUIT.

Wyckoff, Seamans & Benedict,
Appellee,
vs.
The Howe Scale Company,
Appellant.

WALLACE, LACOMBE AND COXE, Circuit Judges.

WALLACE, Circuit Judge, dissenting:—

The only right to use the word "Remington" which the complainant ever acquired from a person of that name was to employ it as a part of the name "Standard Remington Typewriter" in connection with the manufacture and sale of typewriters of the two forms which previous to March, 1886, had been manufactured by E. Rem-

ington & Sons. In April, 1888, the complainant registered a trademark in the patent office consisting of a symbol resembling a seal, red in color, and having in white letters the words "Standard Remington Typewriter". It has also been accustomed to mark its machines with the words "Remington Standard Typewriter".

The defendant (I refer to the party who has assumed the defense of the suit.) has been deprived of using its name, "Remington-Sholes Company", upon its own typewriters, machines which vary in appearance so much from those sold by the complainant that a mistake in identity is impossible except by persons who suppose that "Remington Standard Typewriter", or "Standard Remington Typewriter", and "Remington-Sholes Company", are the same. Doubtless some careless purchasers have been misled, and some unscrupulous dealers have traded on the resemblance imparted by the word Remington; but the defendant is not legally or morally responsible for the deception practiced by others. From the inception of its use of the word it has scrupulously sought to avoid any confusion of identity, and wishing to sell its machines upon their own merits has industriously pointed out that it had no connection with the Standard Remington Typewriter in its advertisements, circulars, and letters of instruction to sales agents.

If the defendant had selected its name for the purpose of unfair competition in trade with the complainant, the question whether the collocation of the word Remington with the other words did not suffice to distinguish its name from the complainant's name would be of little importance, but there is no evidence that it did this except the implication created by its selection of the word "Remington;" and if it selected the word from a legiti-

mate motive any such implication is repelled. The facts attending the selection of its name by the defendant in my opinion show quite conclusively that it did so legitimately.

The defendant is the successor in business of a corporation of practically the same name (The Remington-Sholes Typewriter Company), which was the successor in business of a concern of which the two Remingtons and Sholes were the owners. I agree with the opinion of the court below in the statement that the situation of the new company relatively to any issues raised here is substantially the same as that of the old company, and the inquiry therefore is whether The Remington-Sholes Typewriter Company, in adopting its corporate name, did so legitimately. In 1893 the two Remingtons, sons of the former president of E. Remington & Sons, became interested with Sholes in exploiting a typewriter which the latter had invented, patented, built, and marked with his name as the "Z. G. Sholes Typewriter," the two Remingtons buying a three-fourths interest for about $9,000. Shortly afterwards the name of the machine was changed and it was marked the "Remington-Sholes Typewriter." Between that time and the spring of 1894 the Remingtons had expended besides their original purchase money some six or seven thousand dollars for salaries, shop rent, and other expenses in exploiting the machine, Franklin Remington devoting himself exclusively to the enterprise. In the spring of 1894, in order to interest others and procure thereby the capital required for manufacturing the machine upon a commercial scale and establishing business agencies, the Remingtons and Sholes concluded to organize a corporation. Accordingly they organized the Remington-Sholes Typewriter Company, the Remingtons and Sholes owning two-thirds of the

stock of that corporation and one-third being given to the new associates. The new company at once purchased the necessary tools and machinery, and commenced manufacturing the machines and placing them on the market, and until the summer or fall of 1895 its business was managed entirely by Franklin Remington and Sholes. Undoubtedly in selecting the corporate name they understood that it might suggest some association with the great concern at Ilion, and to that extent that the word Remington was valuable; but that concern was not engaged in the manufacture of typewriters. It was natural that those who had invented the machine, and given all their time and means in introducing it to the public, when they came to organize the corporation which was to represent the culmination of their hopes and efforts, should choose their own name as the corporate name. In doing so I think they were exercising only the common privilege that every man has to use his own name in his own business, provided it is not chosen as a cover for unfair competition. They did not choose the complainant's name literally, or so closely that those using ordinary discrimination would confuse the identity of the two names, and the differentiation is sufficient to relieve them of any imputation of fraud.

I think the decision should be reversed with instructions to dismiss the bill.

EXHIBIT E.

(Order for Mandate.)

At a Stated Term of the United States Circuit Court of Appeals, in and for the Second Circuit, held at the Court Rooms in the Post Office Building in the City of New York, on the 20th day of April one thousand nine hundred and three.

Present: Hon. WILLIAM J. WALLACE,
Hon. E. HENRY LACOMBE,
Hon. ALFRED C. COXE,
Circuit Judges.

Wyckoff, Seamans & Benedict,
Complainant-Appellee,
vs.
Howe Scale Company of 1886,
Defendant-Appellant.

Appeal from the Circuit Court of the United States for the District of Vermont.

This cause came on to be heard on the transcript of record from the Circuit Court of the United States, for the District of Vermont, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged and decreed that the decree of said Circuit Court be and it hereby is reversed without costs, and cause remanded with instructions to decree in favor of complainant only as to the name "Remington."

It is further ordered that a Mandate issue to the said Circuit Court in accordance with this decree.

EXHIBIT F.

(Final Decree of Circuit Court, June 23, 1903.)

At an Equity Term of the Circuit Court of the United States in and for the District of Vermont, held at Windsor, in said District, on the 3d Tuesday of May, A. D. 1903.

Present: Hon. HOYT H. WHEELER, Judge.

UNITED STATES CIRCUIT COURT, DISTRICT OF VERMONT.

Wyckoff, Seamans & Benedict, *Complainant*, *vs.* The Howe Scale Company of 1886, *Defendant*.	In Equity.

It appearing that a decree was heretofore entered in the above entitled cause in favor of the complainant, Wyckoff, Seamans & Benedict, against the defendant, Howe Scale Company of 1886, which, among other things, enjoined the defendant, its officers, agents, etc., from in any manner whatsoever making use of the designation "Remington" or "Rem," as the name or part of the name of any typewriting machine whatsoever, manufactured by the Remington-Sholes Company, and from offering for sale, selling, exposing or advertising for sale, in any manner whatsoever, typewriting machines manufactured by said Remington-Sholes Company, under the name of or as "Remington-Sholes," or "Rem-Sho," or of any designation of which the word "Remington" or the abbreviation "Rem" constituted a part; and it appearing that the said cause was thereafter

appealed to the United States Circiut Court of Appeals in and for the said Circuit Court, and it also appearing that the said decree of the said United States Circuit Court was thereafter reversed without costs and said cause was remanded, with instructions to decree in favor of complainant only as to the name "Remington;"

Now, after hearing Henry D. Donnelly, counsel for complainant, and George P. Fisher, Jr., and F. M. Butler, Esq., counsel for defendant, on consideration whereof upon the mandate herein, it is now ordered, adjudged and decreed and this court doeth hereby order, adjudge and decree as follows, namely:

1. That since about the year 1873 the complainant and its predecessors have been engaged in the manufacture and sale of typewriting machines which became well and favorably known and were marked and designated as "Remington" machines.

2. That said writing machines were put upon the market by complainant and its predecessors and introduced, advertised for sale and popularized in this country and in foreign countries under the name "Remington" and "Remington Typewriter," by which names they came to be widely known and identified by purchasers and the public, and which, before the acts of the defendant and its principal "Remington-Sholes Co.," in the bill of complaint mentioned, had for many years been continuously and exclusively used to designate and identify complainant's machines.

3. That, prior to the act complained of, the complainant acquired and succeeded to the typewriter business founded by E. Remington & Sons, including franchises, trade-marks and good-will thereof, and said business of manufacturing and selling typewriting machines was continued and largely increased and an important good-will

was created and existed which was a source of great profits to complainant.

4. That the defendant, Howe Scale Company of 1886, a corporation existing under the laws of the State of Vermont, has made use, in connection with the sale of typewriting machines manufactured by the Remington-Sholes Company, a corporation existing under the laws of the State of Illinois, of the name and designation "Remington-Sholes" and "Rem-Sho," and has sold and caused the typewriting machines of said "Remington-Sholes" Company to be advertised for sale and to be offered for sale and sold and delivered, by word of mouth and otherwise, under the name of "Remington-Sholes" typewriters and "Rem-Sho" typewriters.

5. That the sale by the defendant, "Howe Scale Co. of 1886," of typewriting machines manufactured by or for the said Remington-Sholes Company under the name of or as "Remington-Sholes" typewriters, constitutes a fraudulent infringement and invasion of the rights of the complainant and an unfair and inequitable competition which equity will restrain.

6. That at the time this action was commenced the defendant, "Howe Scale Company of 1886," was the general agent of the "Remington-Sholes Co." for the United States and that said last named company assumed the defence of this action, agreed to pay and has paid all expenses incident to the defense thereof and agreed to protect and save harmless said defendant with respect thereto.

7. And it not appearing that defendant, as such agent, has received any profits, gains and advantages which have arisen or accrued to it from the infringement of the said trade-name and designation "Remington" by using or selling typewriting machines, having thereon the name

"Remington" as the name or part of the name of said writing machines, an account thereof is denied without prejudice to any right of the complainant to recover the same of the principal, the Remington-Sholes Company.

8. And it is further ordered, adjudged and decreed that an injunction be forthwith issued herein perpetually enjoining the defendant, "Howe Scale Co. of 1886," its officers, clerks, attorneys, agents, servants and workmen and all persons acting in privity with it or them, or claiming through or under it or them from in any manner whatsoever making use of the designation "Remington" as the name or part of the name of any typewriting machine whatsoever manufactured by the Remington-Sholes Company, or by defendant or any person or concern, and from selling, offering, exposing or advertising for sale by means of signs, show-cards, catalogues, circulars, publications, advertisements or by word of mouth, or in any manner whatsoever, typewriting machines manufactured by said Remington-Sholes Company or by defendant, or any person or concern under the name of or as "Remington-Sholes," or by any designation of which the word Remington shall constitute a part.

9. And it is further ordered, adjudged and decreed that an injunction be forthwith issued herein perpetually enjoining the said defendant, "Howe Scale Co. of 1886," its officers, clerks, attorneys, agents, servants and workmen, and all persons acting in privity with it or them, or claiming through or under it or them, from in any manner whatsoever making use of the word "Remington" as the whole or as the part of any name or designation whatsoever, which shall be marked upon, or affixed or applied by any means to typewriting machines, manufactured or sold by the said "Remington-Sholes" company, or by defendant, or any person or concern, and used

by it or them in connection with the manufacture and sale of its or their writing machines and to distinguish and identify the same.

10. And it is further ordered, adjudged and decreed that the said complainant do recover of the defendant its costs, charges and disbursements in this suit in this court, to be taxed by the clerk thereof, and that in default of the payment of the same the complainant have execution therefor.

Done in court this 23d day of June, A. D. 1903, a day in said term.

HOYT H. WHEELER,
Judge.